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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,344

11/12/2003

Edwin D. Neas

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6036

28304 7590 02/13/2009

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SUITE B100

FORT COLLINS, CO 80525-3133

EXAMINER

OBAID, FATEH M

ART UNIT

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3627

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,344	Applicant(s) NEAS ET AL.	
	Examiner FATEH M. OBAID	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the application filed on 11/12/2003.
2. Claims 1-20 are presented for examination.

Claim Objections

3. Claims 10-18 objected to because of the following informalities: Claims 10-18 are reciting the same methods as in Claims 1-9. Therefore, Claims 10-18 are considered as a substantial duplicate of claims 1-9. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-18 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

5. Claims 1-20 are rejected under 35 U.S.C. 101 because:

As per claims 1, 9, and 19, the limitation, "1st condition" as recited is an open-ended conditional statement. The use of open-ended conditional language would not render the entire claim useful, tangible or concrete. The language presented only makes allowances for when 1st condition.

There is no allowance made in the event 2nd condition. Therefore, as the claim is currently presented, it could be possible that there would be no action by the program if 2nd condition. In this case, there would be no concrete, tangible or useful outcome in the case. Thus, the claim is directed to non-statutory material.

Notice:

IF clause, when applicant only describes one-way direction and not the other way.
For example:

1st Condition: IF A is greater than B; then C will _____

Applicant fails to show

2nd Condition: WHAT IF A is not greater than B; what would happened to C!!!!

Even if applicant claims 1st condition in the independent and the 2nd condition in the dependent forms. You will apply the same rule. Because both condition must be claimed together in one independent or dependent claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoff et al. (Hoff).

8. **Regarding Claims 1, 10 and 19:** Hoff discloses a method of building an order for replenishing stock of a fluent substance contained in a flexible-walled vessel for use in a production process at a dispensing location, the method comprising the steps of:

- reading an indicia on the vessel, said indicia comprising information, a portion of which is machine-readable (**at least see Hoff Abstract; Col. 6 Lines 23-37**);
- transmitting at least a part of said indicia information over a network to a remote processor;
- accessing a database with said remote processor to search for a package record that corresponds with said indicia information (**at least see Hoff Col. 6 Lines 23-67, and Col. 18 Lines 1-11**);
- using said indicia information, update and review an inventory file record (**at least see Hoff Figs. 16B-17**),

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- Hoff discloses the claimed invention except for if any; and generating the order for acceptance and, if accepted, automatically transmitting a request for determining a shipping-carrier and availability of stock at a warehouse.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include if accepted automatically transmitting a request for determining a shipping-carrier and availability of stock at a warehouse in Hoff invention, since it was known in the art that to check that the order have been approved and paid for before shipping the order.

9. **Regarding Claims 2 and 12:** Hoff discloses the method of claim 1

- wherein said step of reading further comprises using a computerized device to read said portion which is machine-readable (**at least see Hoff Abstract; Fig. 8**); and
- further comprising the step of awaiting a credit approval for said accepted order prior to performing said step of automatically transmitting a request (**at least see Hoff Abstract; Fig. 8**).

10. **Regarding Claims 3 and 13:** Hoff discloses the method of claim 2

- wherein said computerized device comprises a bar-code reader, and, prior to giving said credit approval, a guarantee of payment of the order must be received by electronic transmission (**at least see Hoff Col. 19 Lines 1-67**); and
- the fluent substance is selected from the group consisting of liquid reagents, cleaning solutions, solvents, and pesticides (**at least see Hoff Col. 8 Lines 40-67**).

11. **Regarding Claims 4 and 14:** Hoff discloses the method of claim 1

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- wherein said step of reading further comprises visually reading said indicia and manually inputting a package serial number thereof to an input device at the dispensing location, said step of accessing further comprises automatically matching said package serial number with a corresponding package serial number in said database **(at least see Hoff Abstract; Fig. 1; Col. 18 Lines 1-67)**, and
- if no said match is found after a second search is performed, input said indicia information for storage in said database **(at least see Hoff Col. 18 Lines 56-67)**.

12. **Regarding Claims 5 and 15:** Hoff discloses the method of claim 1

- wherein: said step of transmitting further comprises connecting to said network through a modem interconnected to a computer-processing-unit (CPU) at the dispensing location where the production process takes place, said network comprising a global information network, and accessing a remote modem interconnected to said remote processor **(at least see Hoff Abstract; Fig. 8)**; and
- prior to an acceptance of the order, a modification is made thereto by input to a computerized-display **(at least see Hoff Col. 16 Lines 1-67)**.

13. **Regarding Claims 6 and 16:** Hoff discloses a system for building the order for replenishing stock of a fluent substance claimed in claim 1

- comprising a computer-processing-unit (CPU) at the dispensing location, said computer-processing-unit (CPU) and said remote processor interconnected to said network through a first and second modem, respectively, and said network comprising a global information network **(at least see Hoff Abstract; Col. 5 Lines 62-67, Col. 6 Lines 1-67)**.

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14. **Regarding Claims 7 and 17:** Hoff discloses a system for building the order for replenishing stock of a fluent substance claimed in claim 1

- comprising a computer-processing-unit (CPU) at the dispensing location, said computer-processing-unit (CPU) and said remote processor interconnected to said network, and said network comprising a local area network (LAN) (**at least see Hoff Abstract; Col. 6 Lines 1-67**).

15. **Regarding Claims 8 and 18:** Hoff discloses the method of claim 1 wherein the order is accepted and said step of automatically transmitting a request comprises, first, checking said availability of stock and if available, selecting said shipping-carrier from any indicated available; and further comprising the steps of:

- prior to said step of using said indicia information, the step of generating said inventory file record to comprise information about the dispensing location and an earlier order for replenishing stock, if made and originating at the dispensing location (**at least see Hoff Col. 27 Lines 1-67**); and
- after said step of automatically transmitting a request, the step of automatically generating an invoice for the order as accepted (**at least see Hoff Abstract; Col. 20 Lines 1-7**).

16. **Regarding Claims 9, 11 and 20:** Hoff discloses the method of claim 1 further

- comprising the vessel comprises an upper-end and a lower-portion having at least one port through which the fluent substance is dispensed during the production process, and prior to said step of reading an indicia, the step of dispensing at least a portion of the fluent substance contained in the vessel during the production process (**at least see Hoff Figs. 1-2**); and

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- wherein said step of reading an indicia is performed at the dispensing location (**at least see Hoff Abstract; Fig. 17**).

Relevant Prior Art

The prior art made of record and not relied upon, which is considered pertinent to applicant's disclosure, are cited in the Notice of Reference Cited form (PTO-892)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FATEH M. OBAID whose telephone number is (571)270-7121.

The examiner can normally be reached on Monday-Friday 8:00 A.M to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000

/F. M. O./

Examiner, Art Unit 3627

2/9/2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627